

IN THE DRAWINGS:

The attached ten sheets of drawings include changes to Figures 5, 6, 7, 9, 12, 13, 15, 16, 17, and 18. These sheets replace the original ten sheets respectively including Figures 5, 6, 7, 9, 12, 13, 15, 16, 17, and 18. Figures 5 and 6 have been amended to remove reference numeral 85. Figure 7 has been amended to change reference numeral 85 to 100. Figure 9 has been amended to remove reference numeral 162. Figure 12 has been amended to change reference numeral 06 to 306. Figure 13 has been amended to change reference numerals 142 to 342 and 144 to 344. Figure 15 has been amended to change reference numeral 492 to 491 and to remove reference numerals 440, 480, and 482. Figure 16 has been amended to remove reference numerals 80, 472, 474, 475, 476, 477, 482, and 499. Figure 17 has been amended to change reference numeral 12 to 512 and to remove reference numerals 500 and 540. Figure 18 has been amended to remove reference numeral 540.

Attachments: Replacement Sheets

REMARKS

Applicant is in receipt of the Office Action mailed March 16, 2005. Claims 1-31 were rejected. Claims 2, 3, 11, 12, 21, and 22 have been amended. Claims 1-31 remain pending in the application.

Objections to the Figures

The Office Action objected to Figures 3, 5, 6, 7, 9, 10, 12, 13, 15, 16, and 17 for various informalities. With regard to Figure 3, Applicant has amended the Specification to note the reference numerals 24', 26', and 32'. Applicant has amended Figures 5 and 6 to remove reference numeral 85. Applicant has amended Figure 7 to change reference numeral 85 to 100. Applicant has amended Figure 9 to remove reference numeral 162. With regard to Figure 10, Applicant has amended the Specification to note the reference numeral 189. Applicant has amended Figure 12 to change reference numeral 06 to 306. Applicant has amended Figure 13 to change reference numerals 142 to 342 and 144 to 344. Applicant has amended Figure 15 to change reference numeral 492 to 491 and to remove reference numerals 440, 480, and 482. Applicant has amended Figure 16 to remove reference numerals 80, 472, 474, 475, 476, 477, 482, and 499. Applicant has amended Figure 17 to change reference numeral 12 to 512 and to remove reference numerals 500 and 540. Applicant has amended Figure 18 to remove reference numeral 540. Regarding the reference numeral 40 noted by the Office Action at page 32, line 2, Applicant believes that the reference numeral 40 correctly and consistently identifies the smart card reader illustrated in the Figures and discussed in the Specification. Accordingly, Applicant respectfully requests that the Examiner withdraw the objections to Figures 3, 5, 6, 7, 9, 10, 12, 13, 15, 16, and 17.

Objections to the Claims

The Office Action objected to claims 2, 3, 11, 12, 21, and 22 for various informalities. Applicant has amended the claims to correct the informalities.

Accordingly, Applicant respectfully requests that the Examiner withdraw the objections to claims 2, 3, 11, 12, 21, and 22.

Section 103(a) Rejections

Claims 1, 4, 10, 13, 15, 20, 23, 25, 26, 29, and 30 were rejected under 35 U.S.C. §103(a) as being unpatentable over Martineau et al. (U.S. Patent Application 08/876,144), hereinafter “Martineau,” in view of Walters (U.S. Patent No. 5,357,573). Claims 2, 11, and 21 were rejected under 35 U.S.C. §103(a) as being unpatentable over Martineau in view of Walters and further in view of Braithwaite (U.S. Patent No. 5,644,444). Claims 3, 12, 22, 27, and 28 were rejected under 35 U.S.C. §103(a) as being unpatentable over Martineau in view of Walters and further in view of Hellman et al. (U.S. Patent No. 4,200,770), hereinafter “Hellman.” Claims 5, 14, 24, and 31 were rejected under 35 U.S.C. §103(a) as being unpatentable over Martineau in view of Walters and further in view of “Windows NT Server.” Claims 6, 7, 16, 17, and 18 were rejected under 35 U.S.C. §103(a) as being unpatentable over Martineau in view of Walters and further in view of Combaluzier (U.S. Patent No. 5,973,475). Claim 8 was rejected under 35 U.S.C. §103(a) as being unpatentable over Martineau in view of Walters and further in view of Teppler (U.S. Patent No. 6,792,536). Claim 9 was rejected under 35 U.S.C. §103(a) as being unpatentable over Martineau in view of Walters and further in view of Hastings et al. (U.S. Patent No. 5,460,411), hereinafter “Hastings.” Claim 19 was rejected under 35 U.S.C. §103(a) as being unpatentable over Martineau in view of Walters and Combaluzier and further in view of Teppler. Applicant respectfully traverses the rejections in light of the following remarks.

Applicant can find no evidence that Martineau (U.S. Patent Application 08/876,144) has been published or issued. Applicant therefore submits that Martineau does not constitute prior art under 35 U.S.C. §103(a). For the purposes of responding to the Office Action, however, Applicant will assume that Martineau is an English translation of Merrien, et al. (PCT No. WO9857474), hereinafter “Merrien,” previously submitted by Applicant in an Information Disclosure Statement.

Merrien discloses a method and a system for using a smart card capable of being inserted in a terminal. Merrien further discloses storing in the card an Internet provider's address, an IP address, and the card user's other personal Internet data; inserting the card in a card reader connected to the terminal; and activating an explorer to use the personal Internet data when the terminal is connected to the Internet.

Walters discloses a memory card (such as a PCMCIA card) which protects against unauthorized copying and use of software saved on the card. A read-only protection code is stored in the memory card. The protected software is supplemented by a protection routine which is activated upon execution of the software. The protection routine reads the protection code from the memory card and compares it to a comparison code contained within the protection routine. Use of the protected software will be allowed only if the two codes match.

Claim 1 recites, in pertinent part:

A processing unit connectable to a data communications network, the processing unit having a device reader for a portable storage device that includes storage operable to supply a network identity for the processing unit and an access controller, the access controller being operable to prevent unauthorised writing to the storage, the processing unit being operable, before reading the network identity from the portable storage device, to attempt a write to the storage of the portable storage device, and, on determining that the write has failed, to read the supplied network identity.

Applicant respectfully submits that the cited references, singly or in combination, do not teach or suggest all the limitations of claim 1. In particular, the cited references do not teach or suggest “the processing unit being operable, before reading the network identity from the portable storage device, to attempt a write to the storage of the portable storage device, and, on determining that the write has failed, to read the supplied network identity.” The Office Action admitted that Martineau does not teach or suggest this limitation. Applicant submits that Merrien also fails to teach or suggest this limitation.

As the Office Action noted, Walters discloses at col. 5, lines 15-21:

It is however possible to include a program routine in the BIOS of the specific PC which can read from the read-only memory device. This routine will initially attempt to write to this memory area. When this does not succeed the protection code will be read to guarantee that it is dealing with a functional protection code.

The protection code in Walters is intended only for internal use by the protection routine in the protected software. The protection code does not supply any information which is used outside of the authorization procedure. In particular, the protection code does not supply a network identity usable for access to a data communications network by a processing unit. Applicant therefore submits that Walters does not teach or suggest “the processing unit being operable, before reading the network identity from the portable storage device, to attempt a write to the storage of the portable storage device, and, on determining that the write has failed, to read the supplied network identity” as recited in claim 1.

In order to reject a claim as obvious, the Examiner has the burden of establishing a *prima facie* case of obviousness. *In re Warner et al.*, 379 F.2d 1011, 154 U.S.P.Q. 173, 177-178 (C.C.P.A. 1967). As stated in the section 2143 of the MPEP (Eighth Ed., Rev. 2), three basic criteria must be met to establish a *prima facie* case of obviousness: “First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.”

Applicant respectfully submits that the Examiner has not established a *prima facie* case for combining any of the cited references. There is no teaching either in the references cited or in the prior art to show how to combine the elements of Merrien with

the elements of Walters. Additionally, as discussed above, the cited references do not teach or suggest all the claim limitations.

Furthermore, there is no reasonable expectation of success because the references cited by the Examiner teach away from each other. Merrien discloses a card which stores an IP address. The IP address openly and publicly identifies Merrien's system on a computer network. By contrast, Walters discloses a card which stores a protection code. The code is strictly for internal use to ensure that copying or use of software is authorized. Making this code public, such as by using it as a network identity, would jeopardize the security of the code and thus undermine the security scheme disclosed by Walters.

For at least the reasons discussed above, Applicant respectfully submits that independent claims 1, 10, 20, and 25 are patentably distinct from the cited references. The remaining dependent claims provide additional limitations to the independent claims. Therefore, Applicant submits that claims 1-31 are in condition for allowance. Applicant respectfully requests withdrawal of the §103(a) rejections.

CONCLUSION


In light of the foregoing amendments and remarks, Applicants submit that all pending claims are now in condition for allowance, and an early notice to that effect is earnestly solicited. If a phone interview would speed allowance of any pending claims, such is requested at the Examiner's convenience.

The Commissioner is authorized to charge any fees which may be required, or credit any overpayment, to Meyertons, Hood, Kivlin, Kowert & Goetzel PC Deposit Account No. 50-1505/5681-04100/BNK.

Also enclosed herewith are the following items:

- ☒ Return Receipt Postcard
- ☒ Replacement Sheets (10 pgs.)

Respectfully submitted,



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